

II. REMARKS

Claims 17 - 60 are pending. Although the Office Action states that “claims 51-60 are withdrawn from consideration” (see Office Action at 1, line item 4(a)), it is believed that these claims are not withdrawn and are presently pending. Thus, examination of these claims is respectfully requested.

The Office Action rejected claims 17 - 50. Office action, line item (6). Applicants respectfully request reconsideration of all pending and new claims in light of the following. The Examiner’s comments from the Office Action are reprinted below in 10-point bold type and are followed by Applicants’ remarks.

A. Claim Rejections - 35 U.S.C. § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 recites, “wherein the customer receives said shipping unit by identifying said shipping unit using said electronic shipment record,...”. It is not clear how one receives by identifying. One receives the shipping unit before it is possible to identify it.

In an effort to more particularly point out the claimed invention, claim 17 has been amended as described hereinafter. Thus, it is believed that claim 17 is in condition for allowance, as described more fully hereinafter.

B. Claim Rejections - 35 U.S.C. § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claims 17-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Southham in view of Reber et al.

Southham shows all of the limitations of the claims except for placing an identification label on the shipping unit, creating an electronic shipment record (invoice), sending the electronic shipment record, and the customer's ability to electronically read the identifier on the label upon receiving the shipping unit.

Southham shows a simple computer facilitated product selling system where the product (shipping unit) is shipped (delivered) to the consumer (shipping unit received).

Reber et al. teaches, figures 1, 4 and 6, a network navigation method using mail. The system shows an article of mail 12 include letters and packages and parcels. Associated with the article of mail are machine readable data 14 (label on shipping unit, see figure 6) Figure 3 is a block diagram of records in a database, such as databases 32 or 34, for determining the electronic address 20. Each of the records (electronic shipment records) includes an electronic address corresponding to delivery-based data for an article of mail. The registration number and the transaction identifier are associated to the label on the shipping unit and the items within the shipping unit. The customer terminal in figure 4 has the ability to electronically read the identifier on the label upon receiving the shipping unit. The system provides a more secure delivery process.

Based on the teaching of Reber et al., it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify Southham system to incorporate to delivery system of Reber et al. in order to provide a more secure delivery process.

Applicants do not acquiesce that the Southam and Reber references are proper prior art references, in light of the Provisional application (filed May 31, 2000 before the issuance of either reference) upon which this pending application claims priority and in light of Applicants' developmental efforts of the claimed invention. However, even if these references were proper prior art references, Applicants respectfully traverse the Examiner's conclusion that they render the listed claims obvious as follows.

In an effort to more particularly point out the claimed invention, independent claim 17 has been amended to include the limitation, *inter alia*, that of "independently identifying the items within the shipping unit using the electronic shipment record received by the customer."

This amendment is proper, as the specification as originally filed supports this amendment. *See, e.g.*, Original Specification, p. 35, ll. 6-23; *id.* at 6 ll. 1-15; 14 ll. 10-14.

Applicants respectfully disagree with the Examiner's characterization of Reber and Southam and contend that these references fall short of disclosing the limitations of the listed claims when properly viewed as a whole. Therefore, Applicants wish to point out the claimed invention as a whole compared to the disclosure of the prior art of record.

Claim 17 is directed to a method of distributing a plurality of items to a customer. Items destined for the customer are placed into a shipping unit, and a label having a unique identifier is placed on said shipping unit. An electronic shipment record is created that identifies the shipping unit by the identifier and listing the items within the shipping unit. The shipment record associates the identifier with the items within the shipping unit. The electronic shipment record is sent to the customer, and the shipping unit is delivered to the customer. The customer then reads the identifier on the label; and independently identifies the items within the shipping unit using the electronic shipment record received by the customer.

In stark contrast to claim 17, (and even the Office Action admits) Southam fails to disclose, teach, or suggest many limitations of the pending claims, and that "Southam shows a simple computer facilitated product selling system where the product (shipping unit) is shipped (delivered) to the consumer (shipping unit received.)" Office action at 3.

Southam discloses "[a]n apparatus and system for allowing customers to purchase boutique or specialty items directly from a supplier or wholesaler. The items for purchase are those conventionally available only through retailers such as local boutiques or specialty shops. An example would be salon quality hair care products. The system allows a customer to visit a website on a computer network, such as the Internet, and place an order for the product by providing information on which products are desired for purchase, the mailing address to which the products are to be sent, payment type, and optionally selecting a local retailer the customer

enjoys frequenting to which the profits are to be directed. The supplier then processes the order and sends the customer the desired products, charging the customer normal retail prices. The supplier protects its business relationships with the local retailer by crediting the retailer for some or all of the profit the retailer normally would have received had it made the sale of the product. The recipient retailer is either chosen by using the retailer selected by the customer during the ordering process or, if a retailer was not chosen, by determining that product-carrying boutique which is geographically closest to the mailing address given by the customer.” Southam Abstract.

Further, Southam provides that:

The instant invention comprises a **system which allows a customer**, or end product user as used herein, **to purchase a product**, normally available only through retailers such as boutiques or specialty stores and not generally sold in department, grocery stores, or mass merchandisers, **directly from a supplier using an electronic communications path** or link, preferably a computer network. Alternatively, the link could be a telephone line, coaxial cable, fiber optic cable, or any state of the art medium over which electronic data may be sent. The customer uses a remote input device such as a computer to access the network, preferably the Internet, and visits the supplier's website. If the customer does not have access to a computer, it is envisioned that the customer contact an order entry site comprising an order entry person with a computer having access to the website. The website gives the customer a choice of products from which the customer designates those desired for purchase. The customer is then directed to provide the address to which the product is to be sent and a payment method. The customer is also given the option to select a third party retailer or store from a provided list to which the predetermined profits of the sale will be sent. The customer should choose the store from which the customer would have purchased the product had this system not been used. If the customer chooses not to select a store, the store geographically closest to the provided mailing address will be chosen automatically by the computer. After the customer has provided all of the necessary information, the customer would hit a "send" button or its equivalent, on the website which would send the order information to a central processing unit. The central processing unit is linked in electronic communication flow to at least one remote output device, preferably a computer. It is envisioned that there are remote output devices located at each supply site, such as a factory, warehouse, or wholesaler, a remote output device used for billing purposes, and a remote output device used for crediting the third party retailers for the sales of the products.

Southam at 2:12-46 (emphasis added).

The order data is received by the supplier's computer and triggers an order processing chain of events. The information is sent to a data bank such as a hard disk drive, random access memory or other magnetic or optical data storage device where the products ordered are noted for inventory and stock replacement purposes. The corresponding products are either designated as sold from a stock inventory or added to the supplier's replacement requirements. The mailing address data is sent to the shipping department of the closest supply source where the product is packaged for shipment. The supply source could be the supplier's factory or main warehouse or one of a number of distribution sources at different locations, such as regional warehouses or distributors. The accounting department receives the data in order to bill the customer and credit the designated store. The marketing department may also access the information for demographic purposes.

Id. at 2:47-63.

Per Southam:

After receiving confirmation at step 66, the consumer will receive the product at step 68 from the distributor selected by CPU 22, delivered via the shipment method chosen at step 62. Finally, at step 70, the consumer will receive a bill for the order. If the payment method chosen at step 64 was a credit card or similar credit arrangement, consumer will receive an invoice or receipt showing that the account was charged for the purchase. Receipt of a bill or receipt at step 70 can occur before, with, or after receipt of the product at step 68.

Id. at 6:21-29. Thus, in Southam, no shipment record (of claim 17) is sent to the customer such that upon receipt, the customer could identify the contents of the shipping unit independently; nor is an identifier on the shipping unit disclosed. Further, even if an identifier such as a barcode were provided, a user of the Southam disclosure could not identify the contents within the shipping container upon receipt. Nor could the user verify the contents by consulting the claimed "shipment record", as none is disclosed, taught, nor suggested therein.

U.S. Patent No. 6,081,827 to Motorola ("Reger") does not correct these deficiencies of Southam.

Reger discloses "[a] network navigation method includes steps of reading machine-readable data (14) associated with an article of mail (12), and determining an electronic address (20) based upon the machine-readable data (14)." Reger Abstract. Further:

The present invention provides a method which comprises receiving an article of mail physically delivered from a sender to a recipient by a delivery service. The article of mail has a bar code which uniquely identifies the article of mail to the delivery service. The method further comprises reading the bar code after the recipient receives the article of mail. The bar code is read by the recipient using a bar code reader. An **electronic address of the sender** of the article of mail is determined based upon at least a portion of the bar code read by the recipient using the bar code reader, and a message is communicated to the electronic address of the sender.

Reber, Summary of Invention 1:65-2:10 (emphasis added).

The present invention further provides a system comprising a translation device, a terminal, a bar code reader, and a digital computing device. **The terminal is for preparing an article of mail for delivery by a delivery service from a sender to a recipient.** The article of mail is prepared to include a bar code which uniquely identifies the article of mail to the delivery service. The terminal is further for communicating bar code data encoded by the bar code and an electronic address of the sender to the translation device. **The bar code reader is usable by the recipient to read the bar code from the article of mail after the delivery service has physically transported the article of mail to the recipient.** The digital computing device cooperates with the bar code reader and the translation device to retrieve the electronic address based upon at least a portion of the bar code read from the article of mail using the bar code reader. The digital computing device further **communicates a message to the electronic address of the sender.**

The present invention still further provides a database comprising a computer-readable medium which stores first bar code data, a first electronic address associated with the first bar code data, second bar code data, and a second electronic address associated with the second bar code data. The first bar code data uniquely identifies a first article of mail physically delivered from a first sender to a recipient at a destination address. The first electronic address is associated with the first sender.

Id. at 2:11 – 2:41.

Thus, Reber discloses a system in which an article of mail is delivered to an end user. The end user may then decode the machine-readable data 14, e.g. by using a scanner, to determine the destination address for the sender of the article of mail. The network may automatically contact the sender via email, etc. “Embodiments of the present invention advantageously provide methods and systems for automatically navigating an electronic network to a destination [e.g. the sender’s electronic address] associated with an article of mail. An end user can navigate to the destination using the article of mail without necessarily knowing the

electronic address for the destination. As a result, the electronic address and the format for the electronic address become more transparent to the end user.” *Id.* at 2:65-3:6.

Only AFTER the recipient scans the barcode is the sender contacted. In the present invention of claim 17, the recipient may independently determine the content of the shipping unit via the shipment record, without contacting the sender. Thus, the scanning in Reber cannot perform the identification of the item’s contents, (nor the verification of the dependent claims,) claimed in independent claim 17.

After determining the electronic address 20 from the machine-readable data 14, the network access apparatus 22 can perform any combination of: linking to the electronic address 20, communicating a message to the electronic address 20, and receiving data from the electronic address 20. By linking to the electronic address 20, the end user 24 can link to a Web page or an online document associated with either the content of the article of mail 12, the sender of the article of mail 12, the deliverer of the article of mail 12, or an advertiser associated with the article of mail 12, for example. By communicating a message to the electronic address 20, the end user 24 can acknowledge receipt of the article of mail 12 to either the sender or the deliverer of the article of mail 12, for example, or can electronically reply to the article of mail 12. By receiving data from the electronic address 20, the end user 24 can receive either an electronic form of information printed in the article of mail 12, information that supplements or augments the information in the article of mail 12, or delivery information, for example.

The steps of linking, communicating a message, and/or receiving data can be performed to facilitate a transaction. For example, the end user 24 can purchase an item, pay a bill, pay taxes, vote in an election, renew a driver's license, renew an automobile registration, make ticket reservations, or purchase a sample of a video or a movie, upon receiving the article of mail 12.

Id. at 7:16-42.

The Office Action states that a “[t]he registration number and the transaction identifier are associated to the label on the shipping unit and the items within the shipping unit.” Office Action at 3. Applicants respectfully disagree. Reber states:

Examples of the article of mail 12 include, but are not limited to post cards, letters, items within envelopes, publications, packages, and parcels. The article of mail 12 can be physically delivered by a postal service such as the United States Postal Service (USPS),

by a parcel service or courier service such as Federal Express and United Parcel Service, or by another delivery service.

Id. at 3:22-28. However, itemization of contents of the article of mail are not disclosed nor suggested.

Associated with the article of mail 12 are machine-readable data 14, and optionally, a human-readable image 16. The machine-readable data 14 is used to navigate to a destination of the electronic network 10 such as an electronic address 20. The optional human-readable image 16 is associated with either the electronic address 20 or a means for navigating to the electronic address 20.

Id. at 3:29-34.

Preferably, the machine-readable data 14 includes data associated with the delivery of the article of mail 12. In this case, the data can assist in the delivery of the article of mail 12, or can identify the article of mail 12, for example.

Id. at 51-55.

In an exemplary embodiment, the machine-readable data 14 includes information-based indicia such as the information-based indicia proposed by the United States Postal Service. In this case, the machine-readable data 14 includes a destination address, a return address, a registration number, a transaction identifier, and a postage license associated with the article of mail 12. The aforementioned information is encoded using a printed code that includes a two-dimensional bar code.

Id. at 56-64.

Thus, in *Reger*, the customer may scan the bar code on the article of mail to determine the sender's electronic address. After the bar code is scanned, the electronic address of the sender may be ascertained and communication may be established. Nothing in *Reger* teaches, discloses, nor suggests that the customer may identify the contents within an article of mail 12 (i.e. determine the items within the shipping unit of claim 17) by scanning the bar code. Further, the customer of claim 17 may independently verify the contents within the shipping unit by utilizing the shipping record. In *Reger*, scanning the barcode only identifies the article of mail, and the sender's electronic address 20, who may then be contacted. However, the scanning of the barcode does not reveal the contents of the article of mail by consulting a shipment record.

Regarding *Reger*, Office Action states, that "[t]he registration number and the transaction

identifier are associated to the label on the shipping unit and the items within the shipping unit.” Office Action at 3. However, as explained above, Reger does not disclose, teach, nor suggest this limitation. Rather, Reger, as explained above, teaches that the customer first scans the article delivered, then establishes communication via an electronic address of the sender. When the article is first scanned by the customer, the contents therein are unknown. Only the information that is present in the indicia (e.g. the article of mail, but not its contents) could be ascertained by the customer.

Thus, Southam and Reger fail to disclose, teach, or suggest each of the limitations of independent claim 17, as amended. As such, neither Reber nor Southam, properly understood, disclose, teach, nor suggest at least the limitations discussed above of independent claim 17. As such, it is believed claim 17 is in condition for allowance.

It is noted that independent claims 26 and 41 also include the limitation of claim 17 that the items within the container or shipping unit may be identified by reading the identifier or barcode thereon. For the reasons set forth with respect to claim 17, it is believed independent claims 26 and 41 are also in condition for allowance.

The Office Action fails to address with particularity claims 18-59. For the convenience of the Examiner, Applicants have constructed the following chart highlighting various novel and nonobvious limitations not addressed in the Office Action.

Further, Applicants particularly point out that none of the prior art of record discloses, teaches, nor suggests the subsequent verification of the contents or recording of discrepancies of the shipping unit to improve the accuracy of the claimed methods.

The Office Action failed to apply the prior art of record to the remaining claims. As such, Applicants are not in a position to rebut any concrete rejections based therein.

As stated above, it is believed that each independent claim presently presented is in condition for allowance. As such, each dependent claim included herein is also in condition for allowance. However, for the convenience of the Examiner, Applicants point out that at least the following new and nonobvious limitations are presented in the dependent claims, and respectfully request full examination of all claims pending in this response:

Claim	Limitation
18	Verifying contents
19	Recording discrepancies
20	Creating delivery record
21	Receipt of record prior to delivery
23	Storing shipment record on PC prior to receiving shipping unit
26	Sending shipment record prior to delivery
28	Verifying
39	Inputting orders into distribution center computer system
40	Providing electronic delivery record
42	Warning signal
43	Electronically recoding discrepancy
44	Delivery record
47	Submitting Order
49	Retail record
51	Customer Database
52	Sending electronic receipt from customer database
55	Electronic invoice
59	Electronically reconciling

It is noted that the above chart provides only an example of the novel and non-obvious limitations presently claimed and not addressed in the Office Action; however, each of the pending claims is believed to be allowable, as described above, and a full and complete examination of all claims is requested. The chart is provided only for the convenience of the Examiner, to ensure that a complete review of the claimed invention is performed.

It is noted that claims 18, 19, 26, 41, and 51 also have been amended to more particularly point out the claimed invention, each amended claim being supported by the specification as

originally filed.

Further, new claims 61 and 62 which add additional novel and nonobvious limitation to claim 17 (the step of receiving the shipment record prior to delivery of the shipping unit, and of acknowledging receipt, respectfully). These claims are supported by the original specification and are therefore proper. *See, e.g.*, Original Spec. at 35, ll. 6-25. Finally, claim 38 has been amended, and new claim 63 has been added, which more particularly point out the aspects of the claimed invention relating to the "Scan:All" mode described at least on page 40 of the specification as originally filed.

D. Conclusion

The Examiner is invited to contact the undersigned attorney at 713.787.1478 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,



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